

S/N: 10/661,018

Atty Dkt No. GP-303369/GM0383PUS

REMARKS

The following remarks are intended to be fully responsive to the Office Action mailed November 3, 2005.

Claims 1-2 and 4-19 are pending. Claims 17 and 18 are objected to. Claims 1-2, 4, and 16-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gruich (2002/0109376). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruich in view of Scott et al. (6,003,923). Applicant has amended claims 1, 16, 17, and 19. Applicant has cancelled claims 6-15.

Claim Objections

Claims 17 and 18 are objected to because of "informalities." The Examiner does not provide a more specific legal basis for the objections.

With regard to claim 17, the Examiner states that "on line 9, 'attaching a second sidewall module' should perhaps be 'attaching one of the second sidewall modules'." Applicant assumes that the Examiner objects to the recitation "attaching a second sidewall module" because claim 17 also recites "a second fastening element ... for mounting any one of a second plurality of differently-configured sidewall modules," and therefore the Examiner's proposed amendment is required for proper antecedent basis.

Although Applicant respectfully submits that the recitation "attaching a second sidewall module" is definite, and does not require the proposed amendment, claim 17 has been amended to delete the first recitation of "any one of a second plurality of differently-configured sidewall modules." Accordingly, since amended claim 17 no longer recites the alleged antecedent for "a second sidewall module," Applicant submits that the objection to claim 17 is moot.

With regard to claim 18, the Examiner states that "on line 2, 'removing a second sidewall module' should be 'removing one of the second sidewall modules'." However, claim 18 depends directly from claim 16; claim 16 does not recite "second sidewall modules." Accordingly, Applicants submit that the objection to claim 18 is improper because amending the claim to conform to the Examiner's suggestion would result in a lack of antecedent basis for "the second sidewall modules." Accordingly, Applicant submits that the objection to claim 18 is improper.

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Claim Rejections – 35 U.S.C. § 102(e)

Claims 1-2, 4-5, and 16-18 are rejected under 35 USC §102(e) as being anticipated by Gruich.

For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

Claim 1 has been amended to recite, *inter alia*, a “sidewall having a forward portion and a rearward portion, said forward portion being characterized by a first height and said rearward portion being characterized by a second height; wherein no part of the sidewall rearward of the forward portion and forward of the rearward portion extends higher than a third height that is less than the first and second heights to form an elongated opening in the sidewall between the cab and the rearward portion.” (emphasis added).

Gruich does not disclose a sidewall having a “forward portion being characterized by a first height,” a “rearward portion being characterized by a second height,” and “wherein no part of the sidewall rearward of the forward portion and forward of the rearward portion extends higher than a third height that is less than the first and second heights,” as recited by amended claim 1. As shown in Figures 1 and 2 of Gruich, the sidewall 15 has a constant height along the length thereof. There is not a portion of the sidewall 15 forward of a rearward portion and rearward of a forward portion where no part of the sidewall extends higher than a height less than the forward portion and the rearward portion. Accordingly, amended claim 1 recites elements and limitations that are not disclosed, either expressly or inherently, by Gruich. Claims 2 and 4 ultimately depend from claim 1 and therefore are not anticipated by Gruich for at least the same reasons that claim 1 is not anticipated by Gruich.

Antecedent support for the amendment of claim 1 is found in Figure 1 and in paragraph 0022 of the present application. More specifically, paragraph 0022 recites “[e]ach sidewall 44 has a forward portion 48, a rearward portion 52, and a midportion 56. The midportion 56 has a height that is less than the heights of the forward portion 48 and the rearward portion 52, thus resulting in an elongated opening 60 between the forward portion and the rearward portion.”

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In conjunction with paragraph 0022 and Figure 1, each sidewall 44 has a forward portion 48 that is characterized by a first height, and a rearward portion 52 that is characterized by a second height which, in the embodiment depicted, is the same as the first height. No part of either sidewall 44 that is forward of the rearward portion 52 and rearward of the forward portion 48 (i.e., at midportion 48) extends higher than a third height that is less than the first and second heights. In the embodiment depicted in Figure 1, both forward portions 48 have the same height, both rearward portions 52 have the same height, and both midportions 56 have the same height.

Claim 16 has been amended to recite a method including, *inter alia*, “possessing a pickup truck, the pickup truck including a cab and a first sidewall ... having a first forward portion and a first rearward portion, said first forward portion being characterized by a first height and said first rearward portion being characterized by a second height; wherein no part of the first sidewall rearward of the first forward portion and forward of the first rearward portion extends higher than a third height that is less than the first and second heights to form a first elongated opening in the first sidewall between the cab and the first rearward portion.”

Accordingly, the analysis presented for claim 1 also applies to claim 16, and therefore claim 16 is not anticipated by Gruich. Claims 17 and 18 depend from claim 16, and therefore are not anticipated by Gruich for at least the same reasons that claim 16 is not anticipated by Gruich.

Furthermore, with respect to claim 18, the Examiner states that “the method [of Gruich] inherently further comprises removing one of the second sidewall modules 50 from the first elongated opening prior to the step of attaching the first sidewall module.” (emphasis added). The Examiner is reminded that to rely on the inherency of a claimed element or feature in a prior art reference, the Examiner must provide extrinsic evidence that the claimed element or feature is necessarily present in the reference. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). See also MPEP § 2112.

The Examiner has not shown that recited elements and limitations of claim 18 are necessarily present in Gruich. Instead, the Examiner merely states that “[s]pecifically, it is apparently [sic] that any one of the modules or bins 50 can be removed from any one of the

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openings once the latch 44 and hinge 42 are disengaged and any further module 50 can replace it.” (emphasis added). Thus, the Examiner does not show that the steps recited by claim 18 are *necessarily present*, but rather merely states that they “can be” present. As stated by MPEP § 2112, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Accordingly, the rejection of claim 18 is improper.

Claim 19 has been amended to recite, *inter alia*, “a sidewall at least partially defining a pickup truck cargo box and having a forward portion and a rearward portion, said forward portion being characterized by a first height and said rearward portion being characterized by a second height; wherein no part of the sidewall rearward of the forward portion and forward of the rearward portion extends higher than a third height that is less than the first and second heights to form an elongated opening.” Accordingly, the analysis presented for claim 1 also applies to claim 19.

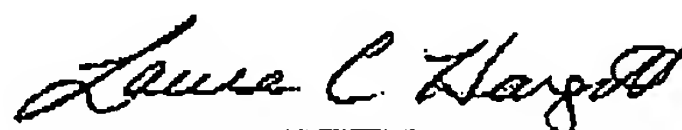
Claim Rejections – 35 U.S.C. § 103(a)

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruich in view of Scott et al. Claim 5 depends from claim 1. Since neither Scott et al. nor Gruich disclose the limitations of amended claim 1, claim 5 is not unpatentable over Gruich in view of Scott et al.

CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed November 3, 2005. The remarks in support of the amended claims and the rejected claims are believed to place all claims in the application in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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